

Remarks/Arguments:

Summary of Changes Made

In the specification, paragraph [0026] on page 6 has been amended to correct a typographical error (the word "filled" was inadvertently misspelled as "filed" in the original application). Paragraph [0035] on pages 8-9 has been amended to delete the prior reference to "locking" fasteners. Applicants intend to pursue this deleted subject matter in a continuation-in-part application.

By this Amendment, claims 1, 2, 13, 15, and 17 have been amended and claims 6, 10-12 and 20 have been canceled. Accordingly, claims 1-5, 7-9 and 13-19 remain in the application.

Claim 1 has been amended to specify that the functioning clock is removably mounted to the front side of the connecting portion of the hub so as to conceal lug nuts tightened down on the lug studs from view, as described in paragraphs [0016] and [0035] of the specification and as shown in Figs. 3-5.

Claim 2 has been amended to specify that the orientation of at least the face portion of the functioning clock does not appear to substantially change when the central portion of the hub of the wheel assembly is mounted against the axle hub of a motor vehicle that is in motion and the hub is rotating, as is described in paragraph [0029] of the specification.

Claim 13 has been amended to correct two typographical errors.

Claim 15 has been amended to correct a dependency error.

Claim 17 has been rewritten in independent form including all of the limitations of the base claim (claim 1) and any intervening claims (claims 2, 3 and 16). The amendments to claims 1 and 2 previously described above have also been included as part of the amendments to claim 17.

No new matter has been added to the application.

Drawings

In the prior Office Action, the Examiner objected to the drawings under 37 C.F.R. §1.83(a) on grounds that certain features of the invention specified in claims 6, 10, 12 and 17 were not adequately shown. By this Amendment, applicants have canceled claims 6, 10 and 12. In addition, applicants have amended claim 17 so as to claim only the structure expressly shown in Fig. 5 and described in paragraph [0035] of the specification (roller bearings 240 and inner annular bearing surface 260 formed in the back case portion 180 of the functioning clock). Applicants intend to file a continuation-in-part application to prosecute the canceled subject matter. In view of the foregoing, reconsideration of the drawing objections is respectfully requested.

Specification

In the prior Office Action, the Examiner objected to the disclosure on grounds that it referred to fastener 290 as a "locking" fastener when the drawings showed the fastener to be a screw or bolt. By this Amendment, applicants have amended paragraph [0035] of the specification to delete the adjective "locking" with reference to the type of fastener used to secure the functioning clock to the connecting portion of the hub of the wheel assembly. Applicants intend to file a continuation-in-part application to prosecute the canceled subject matter. In view of the foregoing, reconsideration of the objection to the specification is respectfully requested.

Claim Rejections - 35 USC §103

In the prior Office Action, the Examiner rejected claims 1, 2, 4, 5, 7, 14, 15 and 19 under 35 U.S.C. §103(a) as being unpatentable over Brown, U.S. Pat. No. 4,793,658, in view of Adkins, GB 2 265 585. Applicants respectfully submit that the teachings of Brown and Adkins cannot properly be combined under 35 U.S.C. §103(a) to read on applicants' claimed wheel assembly.

Brown discloses a wheel cover for covering the opening 16 of the central hub portion of a vehicle wheel 18. Brown states that the primary feature of the invention is

that it provides a vehicle wheel cover which is retained within an opening of a vehicle wheel through leaf springs which are mounted to the cover and are endwise engageable with the wheel within the wheel opening (see col. 1, lines 21-25).

Adkins, on the other hand, discloses an ornamental clock that features a clock kit mounted to a wheel cover from a motor vehicle. Adkins teaches that the ornamental clock can be hung from a hanging dog disposed on a wall for use as a wall-hanging ornament or can be used as an on-desk ornament by resting it on a resting stand (see paragraph that spans pages 7 and 8). Adkins never suggests that the clock kit could be mounted to a wheel cover to be secured to a motor vehicle.

The Examiner's combination of Brown and Adkins is improper under 35 U.S.C. §103(a). As has been repeatedly noted by the Court of Appeals for the Federal Circuit, "[w]hen patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness." *In Re Sang Su Lee*, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). The suggestion, teaching, or motivation to combine the prior art references is an essential component of an obviousness holding, and it must be found in the reference teachings themselves. See, e.g., *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

There is nothing in Brown or Adkins that would motivate anyone to combine the reference teachings for any purpose. Brown and Adkins address entirely different problems in entirely different ways. Brown teaches a way to secure a wheel cover to a wheel of a motor vehicle using leaf springs. Adkins teaches a way of making an ornamental clock that can be mounted to a wall or rested on one's desk by attaching a clock kit to a wheel cover. Neither reference fairly teaches, suggests or discloses mounting a functioning clock to the connecting portion of a hub of a wheel assembly for a motor vehicle as claimed in claim 1 of the present application. Claim 7, which depends from claim 1, is patentable over Brown and Adkins for at least the same reasons claim 1 is patentable over such references.

Claim 2 of the present application further distinguishes the invention from Brown and Adkins. Claim 2, as amended, specifies that the orientation of at least a face portion of the functioning clock does not appear to substantially change when the central portion of the hub of the wheel assembly is mounted against the axel hub of a motor vehicle that is in motion and the hub is rotating. Only Brown teaches a wheel cover for mounting to the central portion of the hub of a motor vehicle, and such a wheel cover would rotate with the wheel as the motor vehicle was in motion. Accordingly, the orientation of the wheel cover according to Brown would certainly substantially change as the wheel rotated. Adkins, on the other hand, never teaches attaching the ornamental clock to the connecting portion of a wheel assembly. Furthermore, if one were to attach the clock kit described by Adkins to a wheel assembly, the face of the clock would appear to substantially change when the wheel was rotated. Claims 4 and 5 depend from claim 2 and are thus patentable over Brown and Adkins for at least the same reasons.

Claims 14 and 15 were rejected in the prior Office Action, but no explanation for the rejection of such claims was included in the Office Action. Applicants note that claim 14 specifies that the connecting portion of the hub comprises a bracket portion for removably mounting the functional clock to the hub. Claim 15, as amended herein, depends from claim 14 and further specifies that the bracket portion is adapted to receive any one of a plurality of interchangeable functional clocks that have a different appearance. Clearly, neither Brown nor Adkins fairly teach, suggest or disclose that the connecting portion of the hub comprises a bracket portion for removably mounting a functional clock to the hub and/or interchangeable functional clocks that have a different appearance.

Also in the prior Office Action, the Examiner rejected claims 3, 6 and 16 under 35 U.S.C. §103(a) as being unpatentable over Brown in view of Adkins as applied to claim 2 further in view of Schindler, U.S. Pat. No. 3,155,430. Schindler discloses a chromatic wheel cover that includes a transparent cap 16 and an inner protective cover 18. However, Schindler does not disclose mounting a functioning clock to a wheel cover

attached to the connecting portion of a wheel assembly of a motor vehicle, and thus cannot be relied upon to meet the deficiencies in Brown and Adkins.

Claims 8-13 were rejected in the prior Office Action under 35 U.S.C. §103(a) as being unpatentable over Brown in view of Adkins as applied to claim 2 further in view of Hinrichs, U.S. Pat. No. 4,381,537. Hinrichs discloses an illusionary wheel cover structure that includes an arm 91 that holds a plate 26 in a stationary, non-rotating position when the wheel of the motor vehicle in which it is mounted in front of is rotating (see col. 3, lines 7-17). A series of lights are disposed in the plate 26, which are sequentially illuminated to provide the illusion of motion.

Clearly, the structure of Hinrichs cannot be combined with the structure of Brown or Adkins to result in applicants' illuminated clock face mounted to the connecting portion of the wheel assembly of a motor vehicle as claimed in claims 8 and 9 of the present application.

Claim 13 of the present application specifies that the clock comprises a receiver for receiving a transmitted time signal, and wherein the controller adjusts the time displayed by the functioning clock to match the transmitted time signal received by the receiver. Again, none of the cited prior art references fairly teach or suggest this structure.

Finally, the Examiner rejected claim 20 under 35 U.S.C. §103(a) as being unpatentable over Brown in view of Adkins and Schindler and O'Donnell, U.S. Pat. No. 5,497,302. O'Donnell discloses a lighted hubcap that snaps onto a wheel assembly of a motor vehicle. As noted above, applicants have canceled claim 20 with the intent of prosecuting the canceled subject matter in a continuation-in-part application. Accordingly, the prior rejection of claim 20 is now moot.

Allowable Subject Matter

In the prior Office Action, the Examiner objected to claims 17 and 18 as being dependent upon a rejected base claim, but indicated that such claims would be allowable if rewritten in independent form including all of the limitations of the base

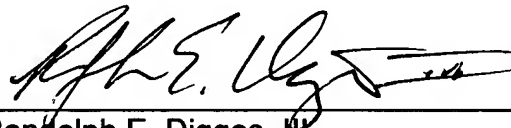
claim and any intervening claims. By this Amendment, claim 17 has been rewritten in independent form including all of the limitations of the base claim (claim 1) and the intervening claims (claims 2, 3 and 16). The amendments to claims 1 and 2 previously described above have also been included as part of the amendments to claim 17. Claim 18 depends from claim 17 and thus does not need to be amended. Claims 17 and 18 are thus in condition for allowance.

Conclusion

In view of the foregoing, the issuance of a timely Notice of Allowance is respectfully requested.

Respectfully submitted,

RANKIN, HILL, PORTER & CLARK, L.L.P.

A handwritten signature in black ink, appearing to read "R. E. Digges, III", is written over a horizontal line.

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